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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Konica Photo Imaging, Inc.

Serial No. 75/898,605

Joel E. Lutzker of Schulte, Roth & Zabel for Konica Photo Imaging, Inc.

Edd Vasquez, Trademark Examining Attorney, Law Office 110
(Chris A.F. Pedersen, Managing Attorney).

Before Quinn, Walters and Chapman, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Konica Photo Imaging, Inc. has filed an application to register on the Principal Register the mark PHOTO STATIONERY for "unexposed photographic paper which becomes writable after exposure and development."¹

¹ Serial No. 75/898,605, in International Class 1, filed January 20, 2000, based on an allegation of a bona fide intention to use the mark in commerce.

The Trademark Examining Attorney has issued a final refusal to register, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive when used in connection with its identified goods.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

The Examining Attorney submitted definitions from *The American Heritage Dictionary of The English Language* (3rd ed. 1992) of "photo" as "a photograph"; and of "stationery" as "1. writing paper and envelopes, 2. writing materials and office supplies." The Examining Attorney also submitted four excerpts of articles retrieved from the LEXIS/NEXIS database showing use of the term "photo stationery," of which two follow:

Is there a future for a technology [digital photography] that lets you see shots instantly on a TV or a PC, print only the best, and even design your own photo stationery? [*San Antonio Express-News*, October 4, 1996.]

After coming up with endless ways of collecting, keeping and displaying photographs, Mr. Bourne launched his mail-order business. Exposures offers photo restoration, the standard fare of picture frames, photo albums and scrapbooks, as well as photo stationery, jigsaw puzzles "and for lazy people like me, shoe boxes," he said. [*The New York Times*, February 7, 1988.]

The Examining Attorney contends that, based on the dictionary definitions alone, PHOTO STATIONERY merely

describes a significant feature of applicant's goods, namely that applicant's goods are "photo stationery, or 'writable' stationery on 'photographic paper' containing photos." He contends that the LEXIS/NEXIS evidence indicates that the term "photo stationery" is used to describe writing paper that contains photographs; and that applicant does not deny that its writable paper, after exposure and development, contains photos.

Applicant contends that PHOTO STATIONERY is no more than suggestive "because of the circuitous reasoning required by prospective consumers to realize that applicant's goods are unexposed photographic paper which becomes writable after exposure and development"; that further inquiry by consumers encountering the mark would be necessary to understand the nature of the goods; that "simply because applicant offers unexposed photographic paper which becomes writable after exposure and development, it does not follow that applicant offers or intends to offer stationery" (*emphasis in original*); that "applicant is not selling pre-printed stationery bearing photographs"; that the mark must be considered in its entirety and applicant's mark is a combination of "two seemingly incompatible terms"; and that the term "photo stationery" is "nebulous." Applicant asks that any doubt be resolved in its favor.

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find that a mark is merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

Considering PHOTO STATIONERY in connection with the identified goods, rather than in the abstract, we conclude that it is merely descriptive in connection therewith. There is no question that "photo" is synonymous with "photograph" or "photographic." It is equally clear that

the term "stationery" encompasses any writable paper.² Applicant's identification of goods is sufficiently broad to encompass paper that can be used, upon exposure and development, as "writing paper" to write a letter, a report, or for any other usual use of blank or decorated paper, and as paper containing photographs that may be described or otherwise labeled by someone writing thereon. The term PHOTO STATIONERY, considered in connection with the identified goods, clearly describes such paper. This conclusion is not changed by the fact that the paper intended to be sold by applicant is "unexposed" photographic paper. It is clearly intended to be used by the purchaser as paper on which to print photographs and write.

We do not find applicant's arguments against a finding of descriptiveness to be persuasive, nor do we have doubt to resolve in applicant's favor.

In conclusion, we find that, when applied to applicant's services, the term PHOTO STATIONERY immediately describes, without conjecture or speculation, a significant feature or function of applicant's goods, namely, that applicant's goods consist of writable photographic paper, regardless of whether it is exposed or unexposed. Nothing requires the exercise of imagination, cogitation, mental

² We rely primarily on the dictionary definitions for these conclusions. While there are few LEXIS/NEXIS excerpts in the record, we find them to be supportive of the dictionary definitions.

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processing or gathering of further information in order for purchasers of and prospective customers for applicant's services to readily perceive the merely descriptive significance of the term PHOTO STATIONERY as it pertains to applicant's goods.

Decision: The refusal under Section 2(e)(1) of the Act is affirmed.